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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/601,479      | 06/23/2003  | Jose E. Lizardi      | MIT-5002            | 7239             |

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EXAMINER

BAXTER, JESSICA R

ART UNIT PAPER NUMBER

3733

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/601,479 | <b>Applicant(s)</b><br>LIZARDI ET AL. |  |
|                              | <b>Examiner</b><br>Jessica R. Baxter | <b>Art Unit</b><br>3733               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 and 12 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11222004</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,674,230 to Tovey et al.

Tovey discloses a suture passer instrument, comprising: a frame (16) having a proximal end and a distal end, said frame having a longitudinal passage (lumen of body portion 16); a bottom jaw member (18) mounted to the distal end of the frame, the bottom jaw having a passage for receiving a surgical needle (24); a top jaw member (20) pivotally mounted (42) to the distal end of the frame such that the top jaw member is moveable with respect to the bottom jaw member, said top jaw member having a distal opening (68); a handle member (14a and 14b) mounted to the proximal end of the frame (FIG. 4), the handle member having a cavity (space between halves 14a and 14b); a jaw actuation member (33) having a top end and a bottom end, wherein the top end of the jaw actuation member is mounted to the handle member (FIG. 4); a needle rod driving trigger member (78) having a top and a bottom, wherein the top of the needle rod driving member is pivotally mounted to the handle member (FIG. 4); a jaw actuation rod (40) having a proximal end a distal end, wherein the jaw actuation rod is slidably mounted in the passage of the frame and wherein the proximal end of the jaw actuation rod engages the top jaw member (FIG. 4), and the proximal end of the actuation rod is mounted to the jaw actuation member (54); a needle

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driving rod slidably mounted to the frame (64, 66), wherein the needle driving member has a proximal end mounted to the needle driving trigger (78) and a distal end for engaging a needle (12); and, a needle passage in the lower jaw having a distal opening out through the top of the lower jaw and a proximal opening in communication with the longitudinal passage of the frame (66).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 3, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tovey et al. '230 in view of U.S. Patent No. 3,842,840 to Schweizer.

Tovey discloses the claimed invention except for the flange member mounted to the top jaw member. Schweizer teaches that a cartridge member is provided in order to provide a length of suture to the device (Column 2, lines 50-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Tovey with a cartridge in order to provide the device with a length of suture that is not directly attached to the needle.

Schweizer discloses that the cartridge comprises an opening that receives a part of the surgical needle (FIG. 6).

***Allowable Subject Matter***

5. Claim 4, 8, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claims 11 and 12 allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R. Baxter whose telephone number is 571-272-4691. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
rb

Jessica R Baxter  
Examiner  
Art Unit 3733

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER